

REMARKS

I. General

Claims 1-18 are pending and all are rejected by the current Office Action mailed on November 17, 2004. Claims 1, 15, and 18 are amended and claim 10 is canceled by the present amendment. The issues in the current Office Action are as follows:

- Claims 1-5, 7, 10-16, and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,956,084 (hereinafter, *Moronaga*).
- Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Moronaga* in view of U.S. Patent 6,195,513 B1 (hereinafter, *Nihei*).
- Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Moronaga* in view of U.S. Patent 6,424,581 B1 (hereinafter, *Bosh*).

II. Amendments

Claim 1 is amended to include the limitations of original claim 10, and claim 10 has been canceled. Accordingly, amended claim 1 corresponds to originally submitted claim 10 in independent form. No new matter is added by this amendment.

Claim 15 is amended to include the limitations of original claim 10. Accordingly, no new matter is added by this amendment.

Claim 18 is amended to included the limitations of original claim 10. Accordingly, no new matter is added by this amendment.

III. Claim Rejections under 35 U.S.C. § 102

Claims 1-5, 7, 10-16, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Moronaga*. Applicant traverses the rejection and asserts the claims are allowable for the reasons stated below.

In order for a patent to be rejected under 35 U.S.C. § 102(b), the cited reference must teach each and every element of the claimed invention. "A claim is anticipated only if each

and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ...claim.” M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Claims 1 and 15, as amended, require that the “controller initiates processing to prepare for removing said long-term image memory from said digital camera including transfer of said digital image from said intermediate memory into said long-term image memory.” Similarly, claim 18, as amended, recites “said control means initiates processing to prepare for removing said second storage means from said digital image capture system including transfer of said digital image from said first storage means into said second storage means.” The Examiner, in the Office Action, asserts that *Moronaga* discloses this element of the claims pointing to selected passages at column 21, lines 53-56; column 22, lines 28-67; and column 23, lines 1-8.

To the contrary, the identified disclosure merely teaches settings on the camera that allows the operator to manually select for the transfer of the images from the internal memory to the long term memory. At column 21, lines 30-59 of *Moronaga*, an external control panel is described with a button for manual selection of the mode (Fig. 9, 222 and 233). All of the cited passages refer to the camera operator manually depressing the mode button to select the transfer of information from the internal memory to the external memory. Further, the selected mode is manually initiated by the camera operator because of the operator’s conscious decision to transfer the images to the long term memory. Claims 1 and 15 recite that the “controller initiates processing” to prepare for removal of the long term memory that includes, at least, the transfer of the digital images from the intermediate memory to the long term memory. Similarly, claim 18 recites that the “control means initiates processing.” There is no such controller in the *Moronaga* reference. The cited disclosure does not show the claimed invention as required for a rejection under 35 U.S.C. § 102. Thus, the Applicant asserts that claims 1, 15, and 18 are patentable over *Moronaga*, and respectfully requests the withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1, 15, and 18.

Dependent claims 2-5, 7, 10-14, and 16 depend directly or indirectly from independent claims 1 and 15, and thus inherit all of the limitations of their respective independent claims. Therefore, Applicant respectfully submits that claims 2-5, 7, 10-14, and 16 are allowable, at least, for the reasons discussed above. Applicant respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2-5, 7, 10-14, and 16.

IV. Claim Rejections under 35 U.S.C. § 103

A. Rejections over *Moronaga* in view of *Nihei*.

Claims 6, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Moronaga* in view of *Nihei*. Applicant traverses this rejection and asserts the claims are allowable, at least, for the reasons stated below.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143.

As explained above with regard to the 35 U.S.C. § 102(b) rejection of claim 1, *Moronaga* does not teach all of the claim limitations of claim 1. Further, *Nihei* does not teach or suggest the limitation of claim 1 that recites in part “said controller initiates processing to prepare for removing said long-term image memory from said digital camera including transfer of said digital image from said intermediate memory into said long-term image memory,” nor was *Nihei* cited for teaching or suggesting such in the Office Action. Therefore, the combination of *Moronaga* and *Nihei* do not teach or suggest all of the limitations of claim 1, nor all of the limitations of dependent claims 6 and 9. Thus, Applicant submits that claims 6 and 9 are allowable, at least, for the reasons discussed above. Accordingly, applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejections of claims 6 and 9.

B. Rejections over *Moronaga* in view of *Bosh*.

Claims 8 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Moronaga* in view of *Bosh*. Applicant traverses the rejection and asserts the claims are allowable, at least, for the reasons stated below.

As explained above with regard to the 35 U.S.C. § 102(b) rejection of claims 1 and 15, *Moronaga* does not teach all of the claim limitations of claim 1 or 15. Further, *Bosh* does not teach or suggest the limitation of claim 1 or 15 that recites, in part, the “controller initiates processing to prepare for removing said long-term image memory from said digital camera including transfer of said digital image from said intermediate memory into said long-term image memory,” nor was *Bosh* cited for teaching or suggesting such in the Office Action. Therefore, the combination of *Moronaga* and *Bosh* do not teach or suggest all of the limitations of claim 1 or claim 15, nor all of the limitations of dependent claims 8 and 17. Thus, Applicant submits that claims 8 and 17 are allowable, at least, for the reasons discussed above. Accordingly, applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejections of claims 8 and 17.

V. Conclusion


In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10011279-1 from which the undersigned is authorized to draw.

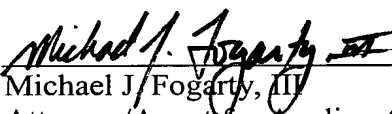
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482745843US in an envelope addressed to: MS Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: January 21, 2005

Typed Name: June Nguyen

Signature: 

Respectfully submitted,

By: 
Michael J. Fogarty, III
Attorney/Agent for Applicant(s)
Reg. No. 42,541
Date: January 21, 2005
Telephone No. (214) 855-8172